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09/881,097	06/15/2001	Valerie De La Poterie	05725.0905-00	7312

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
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SOROUGH, LAYLA

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
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3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8

9  
10 *Ex parte* VALERIE DE LA POTERIE, JEAN MONDET,  
11 and FREDERIC AUGUSTE  
12

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14 Appeal 2008-5435  
15 Application 09/881,097  
16 Technology Center 1600  
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19 Oral Hearing Held: Wednesday, March 18, 2009  
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23 Before TONI R. SCHEINER, DONALD E. ADAMS, and RICHARD M.  
24 LEBOVITZ, *Administrative Patent Judges*.  
25

26 ON BEHALF OF THE APPELLANTS:  
27

28 MARK D. SWEET, ESQ.  
29 Finnegan, Henderson, Farabow, Garrett & Dunner  
30 901 New York Avenue, Northwest  
31 Washington, D.C. 20001-4413  
32

33 The above-entitled matter came on for hearing on Wednesday,  
34 March 18, 2009, commencing at 9:00 a.m., at the U.S. Patent and Trademark  
35 Office, 600 Dulany Street, 9th Floor, Hearing Room B, Alexandria, Virginia,  
36 before Priscilla S. Hopchas, Notary Public.  
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1 PROCEEDINGS

2 THE CLERK: Good morning. Calendar number 20, appeal number  
3 2008-5435, Mr. Sweet.

4 JUDGE SCHEINER: Thank you. Good morning. I apologize we're  
5 getting a late start, my fault.

6 MR. SWEET: Oh, that's okay. I'm right around the corner, so I was  
7 rushing to get here. I was a little late myself, so -- but I think I'll make up  
8 for lost time, too, because I don't anticipate spending much time at all.

9 JUDGE SCHEINER: All right.

10 MR. SWEET: Thank you very much; good morning to all of you.  
11 Single issue in this case, as you know, it seems to me that the Examiner and  
12 I are ships passing in the night versus function and property. And that's  
13 solely what I want to talk about.

14 The Examiner keeps saying you're defining your invention  
15 functionally, and we have been arguing over and over again that we're not  
16 defining it functionally, in fact we've defined it with three specific  
17 properties. And there's really not that much more to say because, I mean, we  
18 have the physical property of it, you know, being semi-crystalline, that we've  
19 recited; we have the physical property of the transition temperature range;  
20 and we have the physical property of the water solubility limitation that's  
21 recited in the claim.

22 So I just want to emphasize that, I don't understand and I'm asking you  
23 to clarify for me if possible, how those physical properties can be viewed as  
24 functional, because we are not defining our thermal transition agent  
25 functionally.

1 JUDGE SCHEINER: Right, the only functional aspect of the claim  
2 would be in the next clause, where it has to function together with the film  
3 forming --

4 MR. SWEET: Sure.

5 JUDGE SCHEINER: -- agent to -- right. But that's not, correct me if  
6 I'm wrong, the Examiner didn't raise that issue --

7 MR. SWEET: No, the Examiner is totally saying you haven't, you're  
8 only defining the thermal transition agent functionally, and that's solely what  
9 we don't understand, because we have those three specific properties. And  
10 in fact we added one of those during prosecution, where we narrowed it  
11 from, where we recited the semi-crystalline nature and narrowed the scope.

12 JUDGE SCHEINER: Right. Your invention, it could be crystalline  
13 or semi-crystalline; you have an example of crystalline, and then you --

14 MR. SWEET: Yeah, we have those polyethylene waxes.

15 JUDGE SCHEINER: And your example, you have the single, or I  
16 guess it's a sub genus of the polycaprolactones?

17 MR. SWEET: Yes, yeah. That's right. Because we have examples in  
18 the spec of all the, excuse me, of the thermal transition agent, some being  
19 crystalline, some non-crystalline, then as you go through the specification  
20 we talk about the hydroxyl number being a class of the semi-crystalline, and  
21 even below that an exemplified subclass of those hydroxyl numbered  
22 semi-crystalline.

23 JUDGE ADAMS: And it would be your position that the  
24 semi-crystalline compound having these particular properties, not  
25 properties -- yes, properties; when combined with the film-forming polymer

1 would necessarily end up with these requirements that you have in the  
2 second clause of your claim; is that correct?

3 MR. SWEET: Oh, I wouldn't say that that's an inherent property, if  
4 that's what you're leading -- I think that that's another limitation of the claim,  
5 that you're going to have to have, you know, those properties, and as you  
6 recognize, no doubt, the limitations in that second clause are really trying to  
7 convey the aspect that it's resistant, it's cold water resistant, but can be  
8 removed by warm water. And those are the properties.

9 But I wouldn't say that that's an inherent property that would  
10 necessarily result from the combination of all of these thermal transition  
11 agents with any film forming agent. I mean this is, this is another limitation  
12 that must be considered.

13 JUDGE ADAMS: And tell me if I'm wrong here, but the Examiner  
14 recognizes that there are other semi-crystalline compounds other than those  
15 that you disclosed in your specification that are known to those in the art; is  
16 that right?

17 MR. SWEET: Okay, sure, I agree with that, yes. And we've had prior  
18 art rejections in the past based, for example, on polyurethanes, and to the  
19 extent that those things are known out there, then they should be applied in a  
20 prior rejection, but for purposes of our discussion today, I think that they can  
21 be identified, and I think certainly the language of our claim shows that the  
22 Appellants were in possession of that concept.

23 JUDGE ADAMS: Any reason, just off the top of my head question  
24 here; any reason why you didn't give the Examiner, you know, a cookie and  
25 say well, here's representative compounds that fall within this --

1 MR. SWEET: Well, in one of my responses I started out by pointing  
2 out that she had rejected the claims, you know, based on prior art, for  
3 example, those polyurethanes. But quite frankly, when I read the response I  
4 didn't like the tone of it, so I backed down from it a little bit. But you know,  
5 also --

6 JUDGE ADAMS: You answered, just a minute --

7 MR. SWEET: Well, I --

8 JUDGE ADAMS: Is that what you're telling me, that you --

9 MR. SWEET: Oh, no, no.

10 JUDGE ADAMS: -- guys got a little hot-headed and you --

11 MR. SWEET: Oh, I don't think so. I mean I was an ex-examiner, I  
12 was here for almost nine years, so I always take great pains to be very  
13 respectful, and my first draft of the response in my opinion may not have  
14 been as respectful as I wanted it, so I toned it back down, because I always  
15 strive to be 100 percent professional and respectful.

16 Trust me, I know; I was on the other side, so I know the arguments.

17 JUDGE SCHEINER: I think we understand the issues, issue, single  
18 issue. So would that be -- unless you have something further, this is --

19 MR. SWEET: I don't, I don't at all, I told you this would be --

20 JUDGE SCHEINER: -- a short hearing.

21 MR. SWEET: -- short and sweet.

22 JUDGE SCHEINER: Yes.

23 MR. SWEET: So thank you very much.

24 JUDGE SCHEINER: Thank you for coming today, and again, I  
25 apologize for getting a late start.

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1           MR. SWEET: No worries, thank you. Have a great day.  
2           (Whereupon, the proceedings were concluded at 9:15 a.m.)  
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